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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/428,982	10/28/1999	DAVID C. ORLOWSKI	P3091	5377
33512	7590	04/07/2006	EXAMINER	
LAW OFFICE OF JAY R. HAMILTON, PLC. 331 W. 3RD ST. NEW VENTURES CENTER SUITE 100 DAVENPORT, IA 52801			PATEL, VISHAL A	
			ART UNIT	PAPER NUMBER
			3673	

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/428,982	Applicant(s) ORLOWSKI ET AL.	
	Examiner Vishal Patel	Art Unit 3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 27-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 27-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| ✓ 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, “the stator having a plurality of radial grooves formed therein with the walls” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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2. Claims 1-16 and 27-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 4-5, “a rotor rotating with the shaft and encompassing the stator”, this claim limitations is unclear. How can the rotor encompass the stator? As claimed in line 4, “a stator affixed to housing and surrounding the shaft”. This 112 error occurs in claims 9 and 27, lines 4-5.

In claim 1, line 6, “the walls”, this limitations lacks antecedent basis. This 112 error occurs in claims 9 and 27.

In claim 1, line 8, “a first wall”, is this first wall one of the walls claimed in line 6 or is this a third wall. For examination purpose a first wall is one of the walls of the groove. This 112 error occurs in claims 9 and 27.

Claim 9, lines 10, “in said in said”, one of the “in said” should be deleted.

Claim 9, line 10, “an axial hole in said walls”, unclear how the axial hole is in said walls. As mentioned in claim 1, the axial hole is in a first wall not all the walls.

Claim 1, “a stator affixed to the housing and surrounding the shaft”, how can an isolator mechanism have a housing and a shaft? This 112 error occurs in claims 9 and 27.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1-2, 6, 9-10, 14 and 27-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Kakabaker et al (US. 4,743,034).

Kakabaker discloses an isolator mechanism that has a stator affixed to a housing and surrounding a shaft and a rotary rotating with the shaft and encompassing the stator. The stator having plurality of radial grooves having walls (grooves 64' and 57'). The groove (groove 57') has a radial dimension that is one-half the radial dimension of the stator (figure 5). A first axial wall of the walls extends between the housing and the shaft (wall having groove 75'). An axial hole in the first wall. The exterior surface of the first wall of the groove facing the interior of the housing. The grooves are adjacent to the shaft (the grooves are adjacent to the shaft) so as strip and collect lubricant adhering to the shaft. The inside diameter of the stator is proportional to the stator diameter.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-5, 8, 11-13, 16, 29-31 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kakabaker in view of Orlowski (US. 5,158,304).

Kakabaker discloses the invention substantially as claimed above but fails to disclose that the axial hole having an elongated circumferential surface that is sloped. Orlowski discloses a stator having a groove and the groove being an elongated groove and having a sloped surface. It would have been obvious to one having ordinary skill in the art at the time the invention was

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made to have the hole of Kakabaker to be an elongated hole and having a sloped surface as taught by Orlowski, to provide a better drainage of lubricating or contaminants. Since have a slope surface makes lubricant or fluid drain quicker and to have a larger hole make the drainage of lubricant faster.

7. Claims 7, 15 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kakabaker and Orlowski.

Kakabaker and Orlowski disclose the claimed invention except that the proportion between the stator and the shaft is 0.005 inches per inch of shaft diameter. Discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Without the showing of some unexpected result. Since applicant has not shown some unexpected result the inclusion of this limitation is considered to be a matter of choice in design. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the proportion to be 0.005 inches as a matter of design choice.

Response to Arguments

8. Applicant's arguments filed 11/21/05 have been fully considered but they are not persuasive. Applicants' argument that the reference of Kakabaker does not teach that the stator closely surrounding the shaft in as much as the rotor is been the shaft and the stator, the stator is removed from the shaft is not closely related is not persuasive because as seen in figure 5, the stator is closely related to the shaft (the first axial wall 86' is closely related to the shaft).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Alun and Fedorovich teach to have a stator having plurality of grooves and a radial groove to drain fluid. Furthermore as evidence is showed by Orlowski patents that it is well know to one skilled in the art of draining lubricant from stator to have grooves or slots or holes and to have sloped grooves or planar grooves.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishal Patel whose telephone number is 571-272-7060. The examiner can normally be reached on 6:30am to 8:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia L. Engle can be reached on 571-272-6660. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VP
March 24, 2006

A handwritten signature in black ink, appearing to read "Vishal Patel", with a stylized, overlapping flourish at the end.

Vishal Patel
Patent Examiner
Tech. Center 3600